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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,955	07/24/2003	David O. Lewis	ROC920030175US1	1644

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IBM CORPORATION, INTELLECTUAL PROPERTY LAW  
DEPT 917, BLDG. 006-1  
3605 HIGHWAY 52 NORTH  
ROCHESTER, MN 55901-7829

EXAMINER

HENEGHAN, MATTHEW E

ART UNIT

PAPER NUMBER

2134

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/04/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/625,955	LEWIS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Matthew Heneghan	2134	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/24/03</u>   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

1. Claims 1-53 have been examined.

### ***Information Disclosure Statement***

2. The following Information Disclosure Statement in the instant application has been fully considered:

IDS filed 24 July 2003.

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: items 508 and 524 in figure 5. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by

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the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

4. The use of the trademark UNIX has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

5. The abstract of the disclosure is objected to because it only describes that which is in the title and the broadest claim. It does not address the disclosure as a whole. Correction is required. See MPEP § 608.01(b).

### ***Claim Objections***

6. Claim 52 is objected to because of the following informalities: the phrase "capacity manager further configured" in line 2 needs a verb. It is being presumed that this should read "the capacity manager is further configured " Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-31 and 33-53 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 7,149,311 to MacKenzie et al.

As per claims 1,8,31, MacKenzie discloses the disabling of a key-utilizing resource via an encrypted user disablement command generated from inputted authorization codes issued via a remote server, which is executed after it is verified (authenticated) (see column 6, lines 43-48).

As per claims 9,10,17,36,46, an algorithm is disclosed in which a verification is performed by decrypting the command to get a value  $b$ , and also generates a field  $\gamma$ , which it then decrypts to derive a value  $\beta$ . If  $\beta$  does not equal beta the disablement operation is aborted by stopping further decryption of it (see column 16, lines 9-38); otherwise, the operation continues.

As per claim 20,22,25-28, the resource is enabled (i.e. unlocked) during initialization via the appropriate codes before disablement (see column 13, line 10 to column 14, line 56).

Regarding claim 38,41,42,45, the authentication may also include the verification of the transmission of random numbers (see column 10, lines 37-53, which is also incorporated into the disablement protocol).

As per 47-51, the device comprises a processor and memory (a plurality of resources) (see column 18, lines 18-31).

As per claims 2,3,39, MacKenzie discloses that use of encryption in verifying the command (see column 17, lines 3-13), based upon the device's unique key information.

As per claims 6 ,7, 15,16,23,24,43,44, the device comprises a processor and memory (see column 18, lines 18-31).

Regarding claim 4,13,14, this command may be issued at any time, regardless of whether or not the unit is active/enabled (see column 5, lines 59-67).

As per claim 11,19. the  $b$  is a function of a key, and is therefore also a key (see column 13, line 11, to column 14, line 12).

As per claim 12,29,34,35,37,40,53, the decryption requires the private key and therefore can only be done on the non-user accessible chip (the smart chip) having the key.

As per claims 21, enablement and disablement are both achieved using the same algorithm (e.g. ElGamal).

Regarding claim 30, encryption for validation is done at the server.

Regarding claims 33, the end user device has an authentication code generator for initialization.

As per claim 52, the user can enable the device by typing and password and can also input a disablement code (see column 6, lines 34-55).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 32 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 7,149,311 to MacKenzie et al.

Regarding claim 32, MacKenzie does not disclose the selling of the device to the user.

Official notice is given that it is well-known in the art to sell end-user devices to potential users, in order to turn a profit.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to sell the devices of MacKenzie to users, in order to turn a profit.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand, can be reached at (571) 272-3811.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**

(571) 273-3800

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

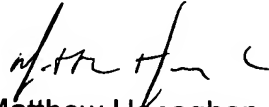


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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MEH

April 1, 2007

  
Matthew Heneghan, USPTO Art Unit 2134